

Attorney's Docket No.:14083-004002

Remarks

Reconsideration and allowance of the above referenced application are respectfully requested.

Initially, and turning to the last rejection first, the patent office questions applicant's contention that Proksch is the sole inventor. In response, a copy of a redacted e-mail between Roger Proksch, and Veeco Instruments is attached. Note from this e-mail, for example on page 3, Proksch's statement "... I will not sign the current documents. I do not believe that they represent a true accurate description of the inventorship".

With this in mind, with all due respect it is stated that James Massey should not be an inventor of this application or, in fact, of the previous patents.

Should the patent office require additional evidence, the undersigned will attempt to secure additional information. However, this is an evidentiary showing, and as such should be considered.

Regarding the patent office's statement that the inventorship on previous cases may be wrong, the attached e-mail shows that to be exactly the inventor's belief.

This should provide evidence that refutes the 35 USC 102(f) rejection made in the official action, which rejection is herein

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respectfully traversed.

Claims 9-13, 22-25, 28,36 and 33-35 and 37 are canceled to obviate the rejection based on Marshall and Prater, et al.

The attached e-mail print-out should provide evidence that refutes the patent office's 102(f) rejection.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

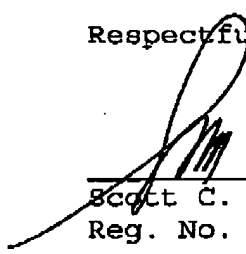
Applicant asks that all claims be allowed. Please apply

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any and all fees for the Petition for Extension of Time or  
credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 4/29/05

  
\_\_\_\_\_  
Scott C. Harris  
Reg. No. 32,030

Fish & Richardson P.C.  
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4350 La Jolla Village Drive, Suite 500  
San Diego, CA 92122  
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Facsimile: (858) 678-5099  
10510428.doc  
Attachment: Redacted email

Scott Harris

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**From:** Roger Proksch [mailto:roger@AsylumResearch.com]  
**Sent:** Friday, July 06, 2001 2:02 PM  
**To:** 'james@di.com'  
**Cc:** Dick Clark; 'Ken Babcock'; 'craig@di.com'  
**Subject:** My recollections of April 9, 1999

Hello James,

Just to set the record straight, here is what I remember. I had the sensor idea, following discussions with you and others at DI about constructing a scanner with an integrated position sensor. I described the idea you in your office. We were discussing things rather frequently back in those days, if you recall. You were also in the midst of intensive salary and options negotiations with Don Kania at the time. During one of your meetings with Don on or before April 9th and following our discussion you told him that you had had a "great new" idea. You then went on to describe to him the sensor idea I had related to you in your office. In your words later you said you felt like you had to "throw him a bone", that you had to "give him *something*". On the 9th of April, after the meeting with Don, you called me rather worried because you claimed you had only remembered that I had come up with the idea *after* your talk with Don. You then assured me that you would tell Don and others that it had indeed been my idea and that credit would go to where it was due.

As for the timing of things, I am sorry if my schedule doesn't fit with your plans. Given the time I've spent writing this, talking to you today and grumping about your attitude, I have already spent more time on it than I can afford. I will get to this when my schedule frees up. Whether it is convenient for you or not, my family and business take precedence. I know, if the roles were reversed, you would feel the same.

Best regards,

Roger

Roger Proksch  
Asylum Research  
[www.AsylumResearch.com](http://www.AsylumResearch.com)

-----Original Message-----

From: Craig Prater [mailto:[craig@di.com](mailto:craig@di.com)]  
Sent: Saturday, July 07, 2001 7:20 PM  
To: 'Roger Proksch'  
Subject: RE: My recollections of April 9, 1999

Roger-

Thanks for your help. We'll be getting you a declaration, the patent application and other paperwork next week sometime. I forget if you are going to Vancouver--if so, I'll look forward to seeing you there.

Craig

-----Original Message-----

From: Roger Proksch  
To: James Massie  
Cc: Ken Babcock; Craig Prater  
Sent: 7/6/01 10:21 PM  
Subject: RE: My recollections of April 9, 1999

Thanks for your email. I'm on my way out the door right now, but I did want to mention at this point that I remember my communications with people somewhat differently than you.

I'm sure you do. It is human nature. For what it is worth, one of the benefits of keeping a journal, especially during stressful times (as it was during the Don K., idea fiasco) is that there tends to be less filtering over time. Still plenty of on the spot filtering, but at least the quotes were pretty much verbatim.

I will try to make through as many boxes as possible this weekend in an effort to make your Tuesday deadline.

Roger Proksch  
Asylum Research  
[www.AsylumResearch](http://www.asylumresearch.com/). <<http://www.asylumresearch.com/>> com  
<<http://www.asylumresearch.com/>>

-----Original Message-----

From: Craig Prater [mailto:[Craig.Prater@veeco.com](mailto:Craig.Prater@veeco.com)]  
Sent: Friday, August 17, 2001 3:06 PM  
To: 'Roger Proksch'; Craig Prater  
Cc: Richard Clark; Ken Babcock  
Subject: RE: Patent reading

Roger-

Glad you had a nice trip. You've given us lots to think about. More later.

Craig

-----Original Message-----

From: Roger Proksch [mailto:[roger@AsylumResearch.com](mailto:roger@AsylumResearch.com)]  
Sent: Friday, August 17, 2001 1:52 PM  
To: Craig Prater  
Cc: Richard Clark; Ken Babcock

Subject: RE: Patent reading

Hello Craig.

Sorry to hear about Andy Nilles (sp?) I had never met the man, but had heard good things about him.

Regarding the patent situation, I have the following points/suggestions:

1. After passing the emails by Dick and discussing patent legalese, I realized I did not do a good job of communicating my beliefs of past events. Let me clarify. I believe that I both invented and reduced to practice while still at Veeco the two main features I discussed in my last(?) email. You might want to take a look around the MFM zone, there were some prototyped scanners with sensors (based on the two ideas I outlined in a previous email) that I had put together before I left Veeco. You might also talk to Karl Koski, he machined some prisms that I put into a prototype. Finally, there should be some Solid Wedge files (backed up?) that I sent to K&G, who then made parts for me. Regarding James' activities since that time, from reading the patent, it seems to me he has taken the invention and simply applied it to the Dimension. I am sure he has done his usual marvelous job of that and that no doubt there are some patentable things he has come up with during this process. I encourage you to seek patent protection on them and will support that to the extent of my abilities.

2. With the above in mind, I will not sign the current documents. I do not believe that they represent a true and accurate description of the inventorship.

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At 10:02 AM 8/13/2001 -0700, you wrote:

>Roger-

>

>Thanks for your email and I certainly appreciate your concerns. And sorry  
>about

>your blood pressure. If you are just back from your vacation, I hope you had a

>great trip and your blood pressure is back to normal! ;-)

>

>Back to the patent. The history here is significantly less sinister that you  
>may be assuming. When James finished working on his new head he started  
>working

>on a patent on the specifics of the head with our attorneys. The draft that  
>came back had excruciatingly narrow claims about the nitty gritty details  
>of his

>head design. I read the patent application at some point and suggested we  
>needed to broaden it to include some of the broader concepts you mention  
>in your

>email among others. At that point it was James who brought up the point that  
>you had contributed some of the conceptual ideas and probably should be an  
>inventor.

>

>We were under some time pressure to file the patent before we publically  
>disclosed the head to some potential customers, so we filed the patent with  
>James as the sole inventor, after researching with our attorneys that it was  
>possible to add you as an inventor if appropriate. After filing the patent  
>application we finished our research into your lab notebooks and  
>determined that

>you should certainly be an inventor based on the claims in the modified  
>patent.

>At that point it took us a while to figure out the details of how to add an  
>inventor work through our concerns about disclosing the details of the new  
>head

>outside DI. Once we worked through these issues, we got you the patent  
>application and the paperwork you have now.

>

>You had some concerns about whether James should be an inventor at all  
>since in

>your mind his involvement was limited to reducing the device to practice. In  
>fact, the patent office requires that an invention be reduced to practice and  
>considers the person who does that work an inventor. For example, Barney  
>Drake

>is a coinventor with Pauls Hansma as he built AFM heads based on concepts from  
>Paul Hansma. (The patent office alternatively considers the granting of a  
>conceptual patent equivalent to reduction to practice.) James worked for more  
>than a year on the detailed head design, so we certainly believe he is an

>inventor of that device, contributing both reduction to practice and many  
>of the  
>more detailed conceptual ideas.  
>  
>Whew!  
>  
>I certainly apologize if the communication on this has been a little  
>convoluted.  
>Since we are at different companies now, some of the communication is much  
>more  
>awkward than any of us would like. Sigh... Anyway, if I have addressed your  
>concerns and you are comfortable signing the docs, I'd be happy to drop by and  
>pick them up. If you have any remaining concerns, please feel free to  
>give me a  
>call or zap me an email.

>  
>Once again, I hope you had a great vacation and I look forward to hearing  
>about  
>it.

>  
>Take care,

>  
>Craig

>  
>  
>-----Original Message-----

>From: Roger Proksch [<mailto:roger@AsylumResearch.com>]

>Sent: Tuesday, August 07, 2001 5:27 PM

>To: Craig Prater

>Cc: Ken Babcock

>Subject: Patent reading

>  
>  
>Hello Craig,

> Thanks for you call and email about my deceptiveness today:)

> I have spent several hours today reading the patent. There is a

> direct

>relationship between time spent doing that and my blood pressure. From  
>what I read so far, my question boils down to something rather  
>simple. Other than doing a nice job of writing about or describing the  
>invention to someone who then wrote it up, it is not clear to me which  
>parts of this James "invented". I do not deny that he has likely done a  
>very nice job of reducing the invention to practice. However, it seems to  
>me that the main points:

>  
>1. A flexure (or bar assembly) that gives some gain to the optical beam  
>position sensor

>  
>and

>  
>2. Reduction or elimination of the parasitic motion from the detector by  
>having the optical (er, electromagnetic radiation (what were you guys  
>thinking about, microwaves???) beam travel along the axis you want to  
>\*not\* measure. Compare, for example, Figure 7 in the application with the  
>figures from my notebook #5 we discussed today.

>  
>were thought of by me while I was an employee at DI. I then related these  
>ideas to James. He then has proceeded to reduce them to practice. The  
>question in my mind now is what constitutes being an inventor for this? I  
>may just be feeling slighted after he went ahead and tried to exclude me

>from the whole process, but it seems to me in my naive view that he should  
>not be listed as an inventor for this. Please bring features of the  
>invention other than these things that are truly novel and a part of the  
>application. I promise to have an open mind. Also, you have my notebooks,  
>perhaps things are not as I remember them. Please let me know if that is  
>the case, I'm not trying to be difficult for the sake of being difficult.

>

> The other thing about this that seems questionable is the manner  
> that I

>learned about the application. Only after volunteering that I had  
>information did I even hear that a patent was being applied for. Over a  
>year ago, James told me that there was no plan to file a patent on the  
>ideas and that we (at Asylum!) were free to use the  
>technology. (!!!?!?!?) Does this have any implications as to the  
>patentability of the invention? I was definitely not an employee at the  
>time of those disclosures and I do not recall any NDA discussions. The  
>down side for you on this is that I now feel very strongly that I should  
>not do anything before I have consulted Dr. Clark, Esq.

>

> So. Where are we? You have my notebooks and I have my  
> memory. As is  
>clear from the already sent in patent application, I cannot control how you  
>decide to proceed with this. However, I am not comfortable signing  
>anything until I these matters are resolved. In addition, I find that this  
>process has taken up a great deal of time. As you know, this isn't what I  
>get paid to do anymore and to spend time getting this stuff straightened  
>out is pretty irresponsible on my part. I also don't think it was handled  
>very well from the Veeco end. I will promise to listen to what you have to  
>say but I would appreciate a much more up front style of communication from  
>now on. For me that means a well thought out response to the points  
>above. Until that is clear in my mind, I can't see spending any more time  
>worrying about this. I have pullers to build and vacation to go on!

>

>Best regards,

>

>Roger

>

>Roger Proksch

>Asylum Research

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Roger Proksch

Asylum Research

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-----Original Message-----

From: Craig Prater [<mailto:Craig.Prater@veeco.com>]

Sent: Wednesday, September 12, 2001 7:41 AM

To: 'Roger Proksch'

Subject: RE: patent application

Roger-

I proposed option 3, take 10 minutes to read the three independent claims we  
identified and decide if you believe you were the sole inventor of those claims or  
if you would agree James is an inventor of those claims. I suppose if you'd like  
to charge us for the time you spend on it that would be fine. But I am really

hoping that neither of us need to spend much more time on this. I know that both of us have better things to do. And if after read these three claims you are unwilling to sign the documents, let me know.

Take care,

Craig

-----Original Message-----

From: Roger Proksch

To: Craig Prater

Cc: Richard Clark; jason@asylumresearch.com

Sent: 9/11/01 9:11 PM

Subject: Re: patent application

Hello Craig.

Yep. It was hard to do much today. I did talk to Irene and she was doing fine. I would be perfectly happy if she takes her time getting back. I'm sure the first flights will be pretty hairy (and scary). I didn't try to talk to Tania about any of this. I don't think she has seen any images about it yet and I think it'll be ok if she doesn't for a few

years. Ugh.

Regarding the patent stuff, before we go any further, I'd like to know which of the options I proposed you would like. From the last email we exchanged:

After I left, James informed me that Veeco in fact would \*not\* be filing a patent on the invention and that we were free to use it. I am working at a different company, one that has no particular interest in having me finish old projects.

Take care.

Roger

At 04:50 PM 9/11/2001 -0700, you wrote:

>Roger-

>

>Wow, what a horrific world we live in. I'm just in shock about this bombing.

>It was pretty surreal trying to explain it to Kenyon this morning...I hope the

>airline stuff gets straightened out soon so Irene can get back as  
>scheduled. We have twenty people trapped around the world with no way  
>to get back to  
Santa  
>Barbara. Geez...Luckily all of them are safe. Keith Konheim's brother  
was  
>actually working on the 15th floor of the World Trade Center when the  
>plane hit.  
>Luckily he got out safely.  
>  
>On the patent stuff...  
>  
>Last time we talked about the patent application I suggested a  
hopefully  
>simple  
>method of proceeding. I suggested that we identify a few claims on  
which we  
>think that James is unquestionably an inventor. I suggested you review  
those  
>few claims and if you agreed with us, we'd ask you to sign the inventor  
forms.  
>If you disagreed with our assessment, you could let us know and decline  
if you  
>wished to sign the documents.  
>  
>We've reviewed some of the claims and would like to suggest you review  
claims  
>10, 18, & 52. These are a sampling of independent claims of which we  
believe  
>James is an inventor. These independent claims have collectively 20  
dependent  
>claims that James would also be an inventor on. This is just a  
>sampling--we've intentionally steered clear of other claims on which we  
>think you and  
James  
>might disagree on the inventorship.  
>  
>You mentioned you believed you were the sole inventor of this patent  
>because you had worked on prototype development that contained:  
>  
>"1. A flexure (or bar assembly) that gives some gain to the optical  
beam  
>position sensor  
>  
>2. Reduction or elimination of the parasitic motion from the detector  
by  
>having  
>the optical beam travel along the axis you want to \*not\* measure."  
>  
>Without passing judgement one way or the other on the origin of the  
concepts  
>above, the three independent claims I've highlighted contain an  
\*additional\*  
>concept:  
>  
>3. Using a flexible coupling that transmit the z-motion of a piezo tube  
  
>without  
>transmitting any parasitic XY motion. See for example the wire  
numbered

>230 in  
>Figs 5 & 7. More than a third of the claims in the patent relate to  
this  
>concept.  
>  
>We also believe that there are numerous other claims dependent on other  
>independent claims that James would be an inventor on, for simplicity  
and to  
>avoid as much contention as possible, just take a look at these three  
>claims.  
>  
>I look forward to hearing from you.  
>  
>Take care,  
>  
>Craig  
>  
>

Roger Proksch  
Asylum Research  
[www.AsylumResearch.com](http://www.AsylumResearch.com)